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U.S. Application No. 10/017,630 Examiner OUELLETTE, Art Unit 3629  
Response to December 8, 2004 Office Action

### **REMARKS**

In response to the office Action dated December 8, 2004, the Assignee respectfully requests reconsideration based on the above claim amendments and the following remarks. Assignee respectfully submits that the pending claims are in condition for allowance.

The United States Patent and Trademark Office (the "Office") rejected the pending claims. Claim 21 was rejected under 35 U.S.C. § 101 for claiming non-statutory subject matter. Claims 27-30 were rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent 6,457,010 to Eldering *et al.* Claims 21-25 and 32-36 were rejected under 35 U.S.C. § 103 (a) as being obvious over Eldering. Claims 26, 31, and 37 were rejected under 35 U.S.C. § 103 (a) as being obvious over Eldering in view of U.S. Patent 6,202,210 to Ludtke *et al.* The Assignee shows, however, that the pending claims are not anticipated nor obviated by the cited patents, and the Assignee thus respectfully submits that the pending claims distinguish over the cited patents.

### **Extension of Time**

Examiner Ouellette, please note this response includes an extension of time. This response includes a petition for a two-month extension of time. The petition also includes the 37 C.F.R. § 1.17(a)(2) large entity fee of \$450. Examiner Ouellette is thus requested to enter this amendment.

### **Rejection of Claim 21 Under 35 U.S.C. § 101**

Claim 21 was rejected under 35 U.S.C. § 101 for claiming non-statutory subject matter. Claim 21, however, has been amended and conforms to the patent laws.

### **Rejection of Claims 27-30 Under 35 U.S.C. § 102 (b)**

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Claims 27-30 were rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent 6,457,010 to Eldering *et al.* A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P."). As the Assignee shows, however, claims 27-30 are patentably distinguishable over *Eldering*. The reference to *Eldering* cannot anticipate this invention, so the Assignee respectfully requests that Examiner Ouellette remove the 35 U.S.C. § 102 (b) rejection of claims 27-30.

*Eldering* does not anticipate independent claim 27. Independent claim 27 has been amended to recites several features that distinguish over *Eldering*. Claim 27, for example, recites "a head end facility receiving i) local content from a local content database, ii) national content from a national content database, and iii) subscriber actions from a subscriber-action database, the subscriber-action database storing information related to actions taken by a subscriber while viewing content." Claim 27 describes a system that provides tailored media content to the subscriber.

No where does *Eldering* teach or suggest such features. Examiner Ouellette is correct — *Eldering* describes "source material." As *Eldering* explains, however, this "source material" is "material that is being viewed by the user." U.S. Patent 6,457,010 to Eldering (Sep. 24, 2002) at column 5, line 25. "*The source material 130, as defined herein, is the content that a subscriber selects.*" *Id.* at lines 26-27 (emphasis added). The "source material" in *Eldering* is what the subscriber selects and views from available programming. Claim 27, on the other hand, describes a head-end facility that receives local content, national content, and the subscriber's actions. This information is then used to predict future actions taken by the subscriber, to create tailored media content that corresponds to the predicted future actions, and to distribute the tailored media content to the subscriber. No where does *Eldering* describe such features.

Examiner Ouellette is also correct — FIG. 9D of *Eldering* shows "local" and "national." FIG. 9D, however, is graphing "the probability that a program being watched is from the given

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category.” *Eldering* at column 10, lines 64-66. As *Eldering* explains, when program characteristics are unknown (e.g., no EPG data or “source related text”), statistics are used to determine the probability that a viewed program has a “local” or “national” category. *Id.* at column 10, lines 62-66. *Eldering*, then, does NOT teach or suggest “a head end facility receiving i) local content from a local content database, ii) national content from a national content database, and iii) subscriber actions from a subscriber-action database, the subscriber-action database storing information related to actions taken by a subscriber while viewing content.”

*Eldering*, then, cannot anticipate independent claim 27. Because *Eldering* fails to teach or suggest all the features of claim 27, *Eldering* cannot anticipate claims 27-30. The Assignee, then, respectfully asks the Office to remove the § 102 rejection and to allow claims 27-30.

**Rejection of Claims 21-25 & 32-36 Under 35 U.S.C. § 103 (a)**

Claims 21-25 and 32-36 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Eldering*. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires “some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill”; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition) (hereinafter “M.P.E.P.”). As this response explains above, *Eldering* does not teach or suggest all the features of claims 21-25 and 32-36.

Claims 21-25 and 32-36 are not obvious in view of *Eldering*. Independent claims 21 and 32 each recite similar distinguishing features. Claim 21, for example, receives content from a local content database, content from a national content database, and subscriber actions from a subscriber-action database. The subscriber-action database stores information related to actions taken by a subscriber while viewing content. This information is then used to predict future actions taken by the subscriber. No where does *Eldering* describe such features.

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Independent claim 32 includes similar features. Claim 32 analyzes i) local content from a local content database, ii) national content from a national content database, and iii) subscriber actions from a subscriber-action database. Tailored media content is created that corresponds to the predicted future actions taken by the subscriber. That tailored media content is distributed to the subscriber. No where does *Eldering* describe such features.

Independent claims 21 and 32, then, are not obvious in view of *Eldering*. The patent to *Eldering* fails to teach or suggest all the features of independent claims 21 and 32. One of ordinary skill in the art, then, would not find it obvious to modify the teachings of *Eldering* to obviate independent claims 21 and 32. Because *Eldering* does not teach or suggest all the claimed features, the Assignee respectfully requests removal of the rejection of claims 21-25 and 32-36.

**Rejection of Claims 26, 31, & 37 Under 35 U.S.C. § 103 (a)**

Claims 26, 31, and 37 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Eldering* in view of U.S. Patent 6,202,210 to Ludtke *et al.* These claims depend upon their respective independent base claim, and thus incorporate all the same distinguishing features. Claims 26, 31, and 37, then, are not obvious over any combination of *Eldering* and *Ludtke*.

**Excess Claim Fees**

This response adds new claims 38-53. No excess claim fees, however, are believed due. The Assignee already paid for the originally-presented (and now cancelled) claims 1-20. New claims 38-53 replace these cancelled claims, and thus no excess claim fee is believed due.

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If any issues remain outstanding, the Office is requested to contact the undersigned at  
(919) 387-6907 or [scott@scottzimmerman.com](mailto:scott@scottzimmerman.com).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized flourish at the end.

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